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Supreme Court of the United States

OCTOBER TERM—1924.

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THE ALEXANDER MILBURN COMPANY,
Petitioner,

vs.

DAVIS-BOURNONVILLE COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

JAMES A. WATSON,
A. PARKER-SMITH,
Counsel for Petitioner.

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To the Honorable the Supreme Court of the United States:

The petitioner respectfully represents unto this Honorable Court as follows:

Statement of Facts.

This suit was brought by Davis-Bournonville Company, respondents, against the Alexander Milburn Company, petitioner, in the United States District Court for the Southern District of New York by Bill of Complaint filed on or about January 31, 1919, alleging infringement of three Letters Patent as follows:

874,666	Gauthier et al.	Dec. 24, 1907
880,099	Rodriques-Ely et al.	Feb. 25, 1908
1,028,410	Whitford	June 4, 1912

Said Court in a decree entered on or about February 9, 1924, held Letters Patent 874,666 and 1,028,410 valid and infringed and patent 880,099 invalid (Record, p. 775). Both parties appealed from said decree to the United States Circuit Court of Appeals for the Second Circuit, and said Circuit Court of Appeals on or about May 26, 1924, filed its opinion (Record, p. 814) affirming the decree of the said District Court.

This petition relates to a question of law affecting the case in respect to patent to Whitford 1,028,410 only, the other two patents not being involved. Claims 3, 6 and 7 of the Whitford patent were in suit.

Ground of Petition.

The writ is prayed for on the ground that the decision of the Circuit Court of Appeals below is in conflict with the decisions of the Circuit Court of Appeals, Sixth Circuit, and the Court of Appeals of the District of Columbia, upon a question of law, the settlement of which is of great importance to the public.

The Question of Law Involved.

The question of law arose in the present case as follows:

1. Plaintiff (Respondent) sued on claims 3, 6 and 7 of the Whitford patent 1,028,410.

2. Defendant pleaded that the patentee, Whitford, was not the original and first inventor or discoverer of any material or substantial part of the thing patented by said Letters Patent No. 1,028,410, but unjustly obtained said Letters Patent for that which was in fact invented by others, citing Harlan A. Clifford, of Jersey City, New Jersey, the patentee of Letters Patent 1,016,613, February 6, 1912, and others. This defense was pleaded under Section 4920 R. S., which

provides that the defendant may plead and prove on trial:

> "Fourth. That he (the patentee) was not the original and first inventor or discoverer of any material and substantial part of the thing patented;"

3. Defendant introduced a certified copy of the file wrapper of patent No. 1,016,613 to Harlan A. Clifford, granted February 6, 1912, in support of this defense.

4. Clifford filed his application Serial No. 605,741 January 31, 1911, and his patent issued February 6, 1912 (Record, p. 659).

5. Whitford filed his original application March 4, 1911 and his divisional application upon which the patent in suit issued January 31, 1912, and his patent issued June 4, 1912 (Record, p. 203).

6. It is conceded that Clifford disclosed in his application of January 31, 1911, but did not claim, the invention covered by the Whitford claims, and that Whitford's application of March 4, 1911, is the earliest record of his invention.

The question of law presented is: Was Whitford the original and first inventor or discoverer of the thing patented to him notwithstanding the earlier disclosure (without claim) of the same thing in the application which resulted in the Clifford patent?

The Honorable Court below answered this question in the affirmative saying in part:

> "For the reasons now set forth we hold that a 'first inventor' within the meaning of that phrase as used in the fourth defence of 4920 must be a person who perfects his invention; no invention can be intellectually perfected unless it is thought out and concluded, and the only evidence of such perfected invention ordinarily derivable from any patent is a union of disclosure and claim.

> Evidence of disclosure only (all we have here) is not enough;—and before publication disclosure alone does not evidence anticipation'' (Record, p. 97).
>
> * * * * * *
>
> ''Result is that we disagree with the ruling of *Lemley vs. Dobson, supra,* and find ourselves in accord with the categorical statement above quoted from *Farmers, etc., Co. vs. Beaver, supra;* holding in conclusion that a patent in evidence under the fourth defense, speaks only from its date of grant, as to all matters disclosed but not claimed therein'' (Record, p. 44).

Lemley vs. Dobson, referred to in the last quoted paragraph, is a leading case in the Sixth Circuit, reported in 243 F. R. 391.

The question presented is also answered in the affirmative by the Circuit Court of Appeals, Seventh Circuit, in Farmers Handy Wagon Co. vs. Beaver Silo & Box Mfg. Co., 236 F. R. 731, 735, in which the Court, speaking by Judge Kohlsaat, said:

> ''The Crosby and Haag patents were co-pending with McClure in the Patent Office. On both of them patents were issued prior to McClure upon applications also filed prior to that of McClure. The appellant contends that these two patents were not in the prior art with regard to the Mc Clure patent, because the several patents granted thereon were subsequent to the date of filing his (McClure's) application.
>
> (1) Among the defenses filed were Nos. 3 and 4, set out in section 4920 of the Revised Statutes (Comp. St. 1913, §9466). They read as follows, viz.:
>
> ''3. That it (the patent) has been patented or disclosed in some printed publication prior to his (the patentee's) supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor.
>
> ''4. That he (the patentee) was not the original and first inventor or discoverer of any material

and substantial part of the thing patented—citing Crosby and Haag, with others, as having previously known of said invention and every material part thereof, and also as having filed applications and received patents thereon."

While under defense 3 aforesaid, in order to be considered in the prior art, the patent cited should have been granted prior to the filing of the application of McClure, yet where the fourth defense is set up, the question as to who was the first inventor is squarely raised, and that matter must be determined on its merits. Barnes Sprinkler Co. vs. Walworth Mfg. Co., 60 Fed. 605, 9 C. C. A. 154; Sundh Electric Co. vs. Rapid Transit Co., 198 Fed. 94, 117 C. C. A. 280. While McClure might have carried his date of invention back to the Crosby and Haag application filing dates, if such were possible, he did not do so. Therefore, Crosby and Haag, having filed their applications prior to McClure's date, must be deemed to have made their several inventions prior to the time when McClure made his. They are thus in the prior art as to McClure for whatever they disclose. *This should, we hold, be limited to such matters as are included in their several claims, unaided by their specifications or by extrinsic evidence except where necessary to elucidate and make the same clear.*" (Italics ours.)

Contra.

In the Sixth Circuit, it has always been held that a patent in evidence under the fourth defense speaks from its application date as to all matters disclosed but not claimed therein, which is in direct disagreement with the decision of the Court below and of the C. C. A., Seventh Circuit, in the Farmers Handy Wagon Co. case, supra. In Lemley vs. Dobson-Evans Co., 243 F. R. 391, 395, C. C. A. Sixth Circuit, with which the Court below states it finds itself in disagreement, it is said:

"(2) This court held, in Drewson vs. Hartje Co., supra, 131 Fed. at page 739, 65 C. C. A. 548, that a patent, the filing date of which antedated the filing date of the patent in suit, was, prima facie, anticipatory; and we have repeatedly accepted and applied that rule (e. g., Electric Co. vs. Westinghouse Co., 171 Fed. 83, 87, 96 C. C. A. 187; Jackson Co. vs. Adler, May 18, 1917, 243 Fed. 386, C. C. A. ; Twentieth Century Co. vs. Loew Co., 243 Fed. 373, C. C. A. , May 8, 1917). To rely upon these cases would be sufficient; but the contrary proposition is urged upon us so often and is observed to such an extent in current decisions that it seems to deserve re-examination. The cases, found cited to support the claim that such a patent is not part of the prior art, are collected in the margin. We are satisfied that the confusion arises out of a question of pleading, and has no foundation in matter of substance."

In the Court of Appeals of the Disritct of Columbia, the question as to whether a patent, disclosing without claiming an invention, when cited as an anticipation, speaks from its application date or from its patent date has been uniformly decided contrary to the holding of the Court below. The decisions of the Court of Appeals, D. C., are of great importance as they control the interpretation of the law in the Patent Office.

In Millett and Reed vs. Duell, Commissioner of Patents, 18 App. D. C. 186; 96 O. G. 1241, the Court of Appeals D. C. said:

"The application was filed on February 17, 1900. It was rejected by the Primary Examiner in an elaborate opinion on reference to a patent issued to one Frederick Lane on February 20, 1900, three days after the filing of the application of the appellants, but which patent had been applied for by Lane upward of two years before. It was contended by the appellants that their application should not be rejected by reference to a patent issued after the filing of their application, in which their alleged invention, if

shown at all, was not claimed, and only appeared in the drawing annexed to the patent; and further that this drawing did not show the invention of the appellants. This contention the Primary Examiner did not sustain; and his ruling was affirmed on appeal both by the Board of Examiners-in-Chief and the Commissioner of Patents. And from the decision of the Commissioner the case has been brought to this Court by appeal.

"With reference to the first branch of the contention of the appellants, we are satisfied that the tribunals of the Patent Office were entirely right in the conclusion reached by them. If the drawings annexed to the Lane patent fully and satisfactorily show the device claimed by the appellants, and if these drawings were the same that were filed with Lane's application in the first instance—and we must assume that they were the same until the contrary is made to appear—it is very plain that they show anticipation of the invention of the appellants. It is of no consequence that Lane does not include this device among the claims of his own invention. His failure so to do simply implies either that he abandoned it to the public, or that he regarded it as already well known to the art. It does not help the appellants in any manner that he does not claim it.

"It is not the fact that a patent was issued to Lane upon his application which constitutes anticipation in this case. Although that patent was issued in so short a time after the application of the appellants that, in view of the usual and necessary course of business in the Patent Office, we might fairly assume that the facts which justified its issue had been satisfactorily shown long before the advent of the appellants to the Office, yet the patent of itself would not be sufficient to show anticipation by Lane of the device of the appellants. But the fact which shows such anticipation is the state of the art at the time as evidenced by the drawings and specifications of Lane's application. For it is the condition of the art at the time at which an alleged invention is made, and not the existence of a patent, which in this connection is

> no more than evidence of the state of the art, which determines whether an invention claimed is actually an invention or not under the patent law. And this state of the art may be shown by a printed book, a periodical publication, a newspaper, anything in fact which can be regarded in law as reasonably sufficient proof of the fact. This we understand to be the rule deduced from reason and the authorities."

In one of the many cases in the Sixth Circuit that are in conflict with the opinion of the Court below Mr. Justice Taft, then Circuit Judge, delivered the opinion. In this case, Cochran vs. Zimmerman, 53 F. R. 801-804, it was held that the patent in suit was anticipated by the patent to Warne which issued about a year later than the patent in suit, the Warne application having been filed five months before complainants filed their application for the patent in suit.

When considering the fourth defense under R. S. 4920 the law in the Second Circuit as stated in the opinion of the Court below is that a patentee claiming an invention is the "first inventor" thereof notwithstanding the existence of a patent disclosing but not claiming the invention based on an earlier filed copending application. The law in the Seventh Circuit as interpreted by the Court below is the same.

The law in the sixth Circuit and in the Court of Appeals, D. C. is, and for many years has been, directly opposed to this doctrine.

The Patent Office, following the Court of Appeals, D. C., has for many years been rejecting later applications upon reference to patents of earlier application date disclosing but not claiming the subject matter claimed in the later applications, when the earlier and later applications have been copending. Irreparable loss is thus being unjustly inflicted upon such later applicants for patents if the interpretation of the law

by the Court below is correct, for the same rule should apply in the Patent Office and in the Courts in determining the rights of a later inventor who claims as against an earlier inventor who discloses but does not claim, assuming that the later inventor files an application before the patent to the earlier inventor has issued.

Wherefore, the petitioner prays:

That a writ of certiorari may be issued out of and under the seal of this Honorable Court, directed to the United States Circuit Court of Appeals for the Second Circuit, commanding and directing said Court to certify and send to this Court, a full and complete transcript of the record of all the proceedings below, to the end that the same may be reviewed and determined by this Court, as provided by law; and that petitioner may have such other and further relief as to this Court may seem appropriate and in conformity with law.

JAMES A. WATSON,
A. PARKER SMITH,
Counsel for Petitioner.

I hereby certify that I am of counsel for petitioner herein, The Alexander Milburn Company; that in accordance with the request of said petitioner, the foregoing petition has been prepared; and that the allegations contained in said petition are true to the best of my knowledge and belief and that said petition is not made for purposes of delay, and is, in my opinion, well founded in law and in fact and should be granted.

JAMES A. WATSON.

Argument.

That there is direct conflict of decision between the Court below and the Circuit Court of Appeals, Sixth Circuit, is so stated in the closing paragraph of the opinion of the Court.

The District Court in the present case gave to this subject able and exhaustive consideration and perhaps no better argument can be advanced in favor of this petition than is contained in the following excerpts from the opinion of the District Court:

> "The question is therefore squarely presented whether on the issue of prior invention it is the claims or the disclosure which counts. That question is unfortunately left in much confusion in the cases" (Record, p. 761).
>
> "In the sixth circuit it has been established by an unusual number of cases that copending applications count precisely as though they were part of the prior art. The comparison on the issue of prior invention is of the disclosures. This has been the rule for over thirty years as established in the following cases" (Authorities) (Record, p. 768).
>
> "Finally in Westinghouse, etc., Co. vs. Metropolitan, etc., Co., 290 Fed. Rep. 681, (C. C. A. 2), it was held that new claims introduced into an application while in the Patent Office did not require any supplemental oath, if the disclosure was unaltered in essentials. This was on the theory that 'what any patentee has invented is theoretically what he discloses and the disclosure is the specification. A claim is a definition of that which has been described in the specification.' Certainly this is inconsistent with the notion that the 'invention' resides solely in the claims.
>
> "Any conclusion amid the confusion of the cases is very doubtful" (Record, p. 766).

The Patent Office has for many years followed the doctrine laid down in Millett & Reed vs. Duell, supra,

by the Court of Appeals, D. C., and has uniformly rejected applications upon patents of an earlier application date disclosing but not claiming the same subject matter. The practice of the Patent Office in this regard is clearly set forth in ex parte Grosselin, 97 O. G. 2977, decided in 1901, and in ex parte Hammond & Hammond, 301 O. G. 1051, decided in 1922. In the latter case it is said:

> "It is believed to be elemental that where there are two patents granted, especially at different dates, there must be two inventions, one invention which forms the basis of one patent and the other invention that of the second patent. A disclosure in a patent is conclusive evidence that the inventor was in possession of a knowledge of what is there discolsed at least as early as the date on which his application was filed. If another patent is to be granted, either to the same or a different inventor, on an application filed subsequently to that on which the patent was granted, such later patent must be for a means or a process involving an invention over what is disclosed in the earlier patent, *whether reached by a claim or not*, unless the filing date of such earlier patent has been overcome by affidavit or judgment of priority." (Italics ours.)

This Court has recognized the importance of harmony between the settled practice of the Executive branches of the Government and the decisions of the Federal Courts, and in the present case it is clear that the opinion of the Court below is directly in conflict with the settled practice of the Patent Office. On this point, this Court said in Bates Refrigerating Company vs. Sulzberger, 157 U. S. 1, 34:

> "If • • • there be reasonable ground for adopting either one of two constructions, this Court, without departing from sound principle, may well adopt the construction which is in har-

> mony with the settled practice of the executive branch of the Government, and with the course of judicial decision in the Circuit Courts of the United States; especially, if there be reason to suppose that vast interests may have grown up under the practice and under judicial decisions which may be disturbed or destroyed by the announcement of a different rule."

It clearly appears there is conflict of decision between the Circuit Courts of Appeal upon the important question of law herein submitted, and it is hoped that an authoritative settlement of the same may be had in the interest of patentees, litigants, and the public generally, and to that end we pray that this petition may be granted.

JAMES A. WATSON,
A. PARKER-SMITH,
Counsel for Petitioner.